



APPLICANT'S REMARKS / ARGUMENTS

1. In response to "Priority" (item 1) in the Office action, certified copies of German applications were sent with the preliminary amendment.

On the "Office Action Summary", it states in item 13 that "some" certified documents have been received. Applicant believes all original German priority documents have been submitted.

If the Examiner needs replacement documents to be submitted, they can be made available and can be resubmitted, to perfect the priority claim. The cost of original German documents is somewhat prohibitive and the time required to obtain them can be lengthy, so notification of the need for new documents will help speed perfection of the claim.

Fee free to contact the agent via his pager number at the end of this reply for timely contact.

2. In response to "Drawings" (item 2) in the Office action:
 - o claim 25 & 26 are canceled,
 - o therefore the drawings, as submitted, meet the tests of 37 CFR §1.83(a).

3. In response to "Claim Rejections" (item 4) in the Office action, claim 25 & 26 are canceled.

4. In response to "Claim Rejections" (item 6, paragraph 1, claim 16 rejection) in the Office action,
 - claim 16 is amended such that the primary attachment of the fastening section includes an internal threading. It is clear two paragraphs down that the fastening section includes an "internal threading of said primary attachment of said body piercing section". It was a simple word processing problem that replaced "internal" with "external" in the forth paragraph of claim 16.

It is further clear that the fastening section has an internal threading by the text of paragraph 42:

[0042] A fastening section 24, with a primary internal threading 25, is attached to primary external threading 21 of body piercing section 19.

Also note that in claim 24, the primary attachment of the fastening section includes an internal threading.

Applicant thanks the Examiner for noticing the internal threading of the fastening section in the drawings.

5. In response to "Claim Rejections" (item 6, paragraph 1, claim 17 rejection) in the Office action,

claim 17 is amended to delete the superfluous words "one of";

claim 17 is amended to change "external" to "internal" in the fourth clause of claim 17, using the same argument 4 above. The claim was originally copied from 16 and edited, so the same typographic error was propagated to claim 17.

6. In response to "Claim Rejections" (item 6, paragraph 2) in the Office action:

- Claim 19 and 20 are being amended to recite a range of less than 180 degrees.
- Claim 19 is amended to change "body piercing section" to "body decoration system", as claim 19 depends from claim 1, we are defining a new body decoration system in claim 19 that has the particular angle, which was what was intended. This mistaken preamble was a simple typographical error, caused by replacement by the word processing software used to draft the application.
- Two new claims, 27 and 28, are added that depended from claim 19 and 20, respectively, are being added to specify the more narrow range of between 90 and 180 degrees.
- These changes are in accordance with MPEP 2173.05(c) I, which states that dependent claims, such as 27 and 28, are not improper under 35 USC 112, second paragraph.
- As these changes are made to clear up the broad and narrow ranges in the same claim, and the ranges that claims 19, 20, 27 and 28 now

specify were disclosed in the application as filed, the changing of claims 19 and 20 and the addition of claims 27 and 28 inserts no new matter to the application.

7. In response to "Claim Rejections" (items 8 - 27) in the Office action

- Applicant respectfully requests the Examiner reconsider all 103 rejections in this Office Action.
- Applicant considers that the invention that would result from all combinations of Erickson (4,781,036) with Hoffman (2,316,225), and all "inventive insight" that someone skilled in the art could bring to bear, would not result in the Applicant's current invention. Specifically:
 - There is no head section keeping the post in place in Erickson, and combining Erickson with Hoffman would allow one skilled in the art to remove a decorative section but not while leaving a head section in place, resulting in the piercing securely remaining in the body opening.
 - Looking at the Examiner's comments in item 10 and 12 it appears that the Examiner believes that the top decorative element in Hoffman's figure 1 is the decorative section and that the element 3 is a head section in which element B attaches.

The Applicant respectfully notes that the duplicated elements 5 and 4 in Hoffman are for separate decorative sections shown together, perhaps in the act of exchanging decorative elements.

The citation of element 3 in Hoffman as a head runs contrary to the Examiner's citation in item 8 of the Office Action that element 4 in Hoffman is a head section.

Note that the description, in column 2 line 16 of Hoffman states:

"the base 4 may be detached from said ring, together with the corresponding stone or ornament 3, substituting this latter by a new stone or ornament 6..."

It is obvious therefore, that to exchange element 3 with element 6 in Hoffman, the entire subassembly consisting of elements 3,4,5 and A must be replaced with a subassembly consisting of elements 6,4,5 and B. There is no head section to which either of these subassemblies attaches.

If the Examiner did, indeed, believe that the top decorative element in Hoffman's figure 1 is the decorative section and that the element 3 is a head section in which element B attaches, the Applicant respectfully believes this indicates impermissible hindsight. Applicant believes a head section to which a decorative section attaches, while being attached to a body piercing section was not within the skill of one who was skilled in the art. Applicant believes the Examiner's citation of a head section in Hoffman was in fact being taken from the Applicant's disclosure. In effect, the Examiner, with knowledge of the Applicant's disclosure, extrapolated that element 3 in Hoffman was a head section. Without the Applicant's disclosure, such an extrapolation is not possible.

- Erickson and Hoffman do not mention an infection risk, nor do they mitigate an infection risk, as does the Applicant's current invention. With Hoffman there is no infection because there is no body opening, with Erickson the decorative section must be removed from the post, exposing the body opening to infection, as does removal of the post.
- The removable cap of Erickson is NOT a head, as the Examiner states in item 9 of the Office action. It is merely a flat, simple decorative element meant to assist in the insertion of the earring using a piercing device, and to aid in healing.
- The head section of the Applicant's current invention has two attachments, one to attach it to the body piercing section and one to attach it to the decorative section. All cited references do not teach any element being attached to a body piercing section that has another attachment, the head section of the current invention is one of its unique, non-obvious features.
- The ring portion of Hoffman cannot be combined with Erickson to achieve the head section of the Applicant's current invention. It is the fact that the head section of the Applicant's current invention keeps the body piercing section in place and allows the removal of the decorative section

without removal of the body piercing section that mitigates infection risk and risk of loss of the body piercing section, head or attachment sections that is a non-obvious step the Applicant has made with the current invention.

- When Erickson is combined with Hoffman, and one removes a decorative element, there is no head element in place to hold the post in place and it would fall out; therefore Erickson does not disclose a decoration system that is substantially the same as the present invention, where the body piercing section can not fall out due to the action of the head, body piercing, and fastening sections of the Applicant's current invention.
- The Examiner states that Erickson does not disclose a "head element", which is true, but then, the Examiner states that there is a "head element" in Hoffman, specifically reference (4). The citation of element 4 in Hoffman as a head, in item 8 of the Office Action runs contrary to the Examiner's citation that element 3 in Hoffman is a head section.
 - Element 4 in Hoffman is actually the base of a decorative section consisting of elements 3,4,5 and A (or 6,4,5 and B); there is no separate head section in Hoffman or Erickson, and no motivation in the drawings or descriptions of the respective patents to lead one skilled in the art to create a head section as in the Applicant's current invention.
 - Element A or B in Hoffman is a primary attachment of the decorative section, roughly analogous to element 7 in the Applicant's current invention, except that in Hoffman there is no head section disclosed or possible.
 - Further, there is no separate head section that can detach from a decorative section while leaving a body piercing section (as in the present invention or in Erickson) or a ring section (as in Hoffman) in place.
 - There is no advantage to the wearer to be able to detach the decorative section in Hoffman, while wearing the ring section. In fact, doing so may be more cumbersome. The purpose of Hoffman is to provide one ring with multiple decorative elements, and perhaps to reduce costs, not to provide a head section that stays in place for health, safety and utility reasons while allowing decorative sections to be

exchanged, as is the case with the Applicant's current invention.

- There is no motivation to combine Erickson and Hoffman as they are solving different problems.
 - The reason Erickson makes front cap (12) removable is to facilitate the insertion of the invention in an ear lobe using a "usual ear piercing device". After the ear has been pierced, the wearer may unscrew cap 12 and replace it with a decorative element. Applicant believes Erickson makes the cap replaceable to mitigate the cost of a separate stud for initial piercing and healing.
 - It would be more dangerous for Erickson to make cap 12 a decorative section as a decorative section that contains a gem could be damaged when inserted into a standard ear-piercing device, or it could damage or jam the ear-piercing device, or the decorative element could cause infection to the newly pierced ear.
 - It is common practice in the art that a plain gold or stainless element, for example a stud, be worn in a newly pierced ear, for a period of time, while the piercing heals.
- As stated in US patent 6,183,490 to **Korbar**:

"The risk of infection is further significantly increased by the typical impatience of individuals who want to change jewelry (i.e., replace the piercing earring) before the pierced tissue fully heals. In fact, to the extent such piercing earring is prematurely removed, the piercing formed by the piercing earring heals and ultimately closes, thus defeating the entire piercing experience. Such problems are especially common among younger individuals. In this regard, the widely acknowledged contributing factor to such problems is the belief of the customer that, after piercing, the pierced hole will be permanent in six weeks, as opposed to the more correct time of six months."

(column 1, line 65 to column 2 line 15 – Korbar '490)
- Only the current invention, and not an invention created by Erickson in view of Hoffman allows the decorative element to be changed in a body opening, while the opening is still healing and without removing any element that comes in contact with the healing tissue. That is to say, the current invention provides a head section, a body piercing section and

an attachment section that may remain in the newly pierced body opening as long as the wearer desires, while allowing the wearer to exchange decorative sections whenever they wish.

- Erickson teaches away from Hoffman because Erickson could have no removable decoration on a head, as is the case with the Applicant's current invention.
- The combination of Erickson and Hoffman do not constitute the current invention, therefore Erickson in view of Hoffman is not "a body decoration system substantially as claimed". The Applicant, therefore, respectfully requests that the Examiner reconsider all 103 rejections in the current action, and examine the claims accordingly.

8. In response to "Allowable Subject Matter" (item 28) in the Office action:

- Claim 18 is canceled.
- A new independent claim 29 is written that overcomes the 35 USC 112 second paragraph rejection(s) and includes all the limitations of original claim 1.
 - This new independent claim includes the limitations of deleted claim 18 in that the angle is between 90 and 135 degrees.
 - A new independent claim 30 is added that is a copy of claim 29 except that it includes an angle less than 180 degrees, as originally expressed in claim 19, before the current amendment.
- A new dependent claim 31 is added, which depends from claim 30, and includes an angle between 90 degrees 180 degrees as originally expressed in deleted claim 19.
- Applicant believes new claim 29 includes all the requirements indicated in Examiner's "Allowable Subject Matter" citation, and as such, Applicant respectfully requests a timely notice of allowance be issued for claim 29.
- New claim 30 is added independent from claim 29, so that the Examiner's instructions in the Allowable Subject Matter section is respected and to speed allowance of claim 29, although the Applicant respectfully is inserting independent claim 30 and dependent claim 31 in an attempt to give the same scope of

protection as other amendments to this action. If the Examiner believes claims 30 and 31 recite the same claims as other amended claims in this reply, Applicant will cancel one or more claims to speed allowance.

- Applicant would prefer an independent claim that includes the angle of "less than 180 degrees", a dependent claim that includes an angle of "between 90 degrees and 180 degrees" and another dependent claim that includes an angle of "between 90 degrees and 135 degrees", because Applicant believes the 103 problems with Erickson and Hoffman have been successfully argued.
- If claim 29 were allowed, the Applicant would want dependent claims that were not examined due to 103 rejections to be included in the scope of coverage. Rather than including dependent claims with this reply, Applicant will respectfully wait until the Examiner has had a chance to comment on Applicant's 103 arguments, which Applicant believes are persuasive enough so that claims dependent from 29 would not be needed.

--- end of amendment ---

We further specify that a clean copy of the application, after making the included changes, is included as a separate enclosure. There are no changes to the drawings, therefore, the originally filed drawings should be used.

Applicant respectfully requests that a timely notice of allowance be issued in this case.

Respectfully Submitted,

Lawrence Robert Brandt

Agent for Applicant Lasar

USPTO Reg. # 46,575

Contact Info: Pager: 1-877-870-9433